



Attorney Docket No. 63001.000005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application Of:

Charles A. SHOTTON, Jr. *et al.*

Application Number: 09/902,796

Filed: July 12, 2001

For: **APPARATUS FOR AND
METHOD OF SELECTIVELY
RETRIEVING INFORMATION
AND ENABLING ITS
SUBSEQUENT DISPLAY**

) Group Art Unit: 2171

) Examiner: Cam-Linh NGUYEN

) Confirmation No.: 7467

SUBMISSION OF APPEAL BRIEF
UNDER 37 C.F.R. § 1.192(a)

Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22303-1450

Sir:

Appellant attaches hereto an Appeal Brief, filed in triplicate, in connection with the above-captioned patent application. A Notice of Appeal was filed on March 29, 2005. Pursuant to 37 C.F.R. § 1.192(a), a check in the amount of \$250.00 is enclosed for the small entity fee for filing an appeal brief pursuant to 37 C.F.R. §1.17(c). If any deficiency in the amount paid and the amount due exist, please charge the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

HUNTON & WILLIAMS

By:

Jeffrey Scott Leaning
Registration No. 51,184

Dated: June 29, 2005

1900 K. St., NW, Suite 1200
Washington, D.C. 20006-1109
Telephone (202) 955-1500
Facsimile (202) 778-2201



Attorney Docket No. 63001.000005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application Of:)
Charles A. SHOTTON, Jr. et al.) Group Art Unit: 2171
Application Number: 09/902,796) Examiner: Cam-Linh NGUYEN
Filed: July 12, 2001) Confirmation No.: 7467
For: APPARATUS FOR AND)
METHOD OF SELECTIVELY)
RETRIEVING INFORMATION)
AND ENABLING ITS)
SUBSEQUENT DISPLAY)

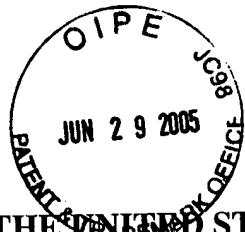
APPEAL BRIEF

06/30/2005 SSITHIB1 00000156 09902796
02 FC:2402

250.00 op

TABLE OF CONTENTS

	<u>Page</u>
I. REAL PARTY IN INTEREST.....	1
II. RELATED APPEALS AND INTERFERENCES	1
III. STATUS OF CLAIMS	1
IV. STATUS OF AMENDMENTS	1
V. SUMMARY OF CLAIMED SUBJECT MATTER	2
VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL	6
VII. ARGUMENTS	6
VIII. CONCLUSION.....	25



Attorney Docket No. 63001.000005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application Of:)
Charles A. SHOTTON, Jr. *et al.*) Group Art Unit: 2171
Application Number: 09/902,796) Examiner: Cam-Linh NGUYEN
Filed: July 12, 2001) Confirmation No.: 7467
For: **APPARATUS FOR AND**)
METHOD OF SELECTIVELY)
RETRIEVING INFORMATION)
AND ENABLING ITS)
SUBSEQUENT DISPLAY)

APPEAL BRIEF

In response to the Final Office Action dated December 3, 2004 (hereinafter, the “Final Office Action”) finally rejecting pending claims 1-29, Appellant respectfully requests that the Board of Patent Appeals and Interferences (hereinafter, the “Board”) reconsider and withdraw the rejections of record, and allow the pending claims, which are attached hereto as an Appendix.

I. REAL PARTY IN INTEREST

The real party in interest is BIAP Systems, Inc., the assignee of the above-referenced application.

II. RELATED APPEALS AND INTERFERENCES

To the best of Appellant’s knowledge, there are no related Appeals or Interferences.

III. STATUS OF CLAIMS

Claims 1-29 are pending and stand rejected in this application. The rejections of claims 1-29 are appealed.

IV. STATUS OF AMENDMENTS

No amendments to the claims have been filed subsequent to the Final Office Action dated December 3, 2004. Appellant filed its notice of appeal on March 29, 2005.

V. SUMMARY OF CLAIMED SUBJECT MATTER

In general, the claimed invention relates to selective retrieval and display of data. More particularly, the claimed invention relates to retrieving one or more sets of data from within a broader collection of data and presenting such retrieved data to a user. *See, e.g.*, Specification, paragraphs 2 and 42. The claimed invention is intelligent, in that it learns to identify certain subsets of data in, for example, a web page. From this identification, the claimed invention is able to subsequently retrieve similar data even though, for example, its content or location within the web page has changed. Specification, *e.g.*, paragraphs 60 and 61. The claimed invention learns to identify such data subsets by analyzing their semantics, syntax, or position. Specification, *e.g.*, paragraph 44. Certain embodiments of the invention make use of software agents to identify and retrieve content. Specification, paragraphs 31-43.

As a particular, non-limiting, exemplary embodiment of the invention, consider a browser window configured to display the current news headlines from five web-based magazines and newspapers. Specification, paragraphs 80-82. Such an embodiment may include agents that monitor each of the five web sites to retrieve and store content therefrom. The agents retrieve and store each of the five headlines and corresponding opening paragraphs, for example, but display only the headlines to the end user. Specification, paragraph 81. Should the user desire to view one or more opening paragraphs, he or she need only click on the appropriate headline, and the opening paragraph will be retrieved from storage and displayed without the need to be contemporaneously connected to the internet. Moreover, the embodiment is able to intelligently retrieve the specified content as discussed above, regardless of whether the particular content or location within the page, for example, has changed subsequent to a prior retrieval.

A. INDEPENDENT CLAIMS 1 AND 22

Independent claims 1 and 22 are similarly-structured, with claims 1 directed to a method

and claim 22 directed to a system. Both claims recite “retrieving a first set of data from a first predetermined data source, said first set of data including a second set of data.” For support, *see, e.g.*, Specification, paragraphs 21, 22, 31, 40, 41, 42 and 60. With respect to “said first set of data including a second set of data” in particular, *see, in addition*, Specification, paragraph 81, for example. Claims 1 and 22 further recite “analyzing semantics, syntax, or position of said second set of data within said first set of data.” *See, e.g.*, Specification, paragraphs 44-73. Claims 1 and 22 further recite “building an agent, said agent comprising instructions based on said analysis of said semantics, syntax, or position of said second set of data, wherein said instructions are to be used by said agent to subsequently retrieve a third set of data from said first predetermined data source and select a fourth set of data included in said third set of data.” *See e.g.*, Specification, paragraphs 44-73; *see especially* paragraph 59.

Independent claim 1 contains limitations that are drafted in means-plus-function form under 35 U.S.C. § 112, sixth paragraph. Specifically, claim 1 recites “retrieval means for retrieving...,” “analyzing means for analyzing...,” and “means for building an agent....” The reader is directed to the above paragraph for references to portions of the specification that describe the structures corresponding to the claimed means.

B. INDEPENDENT CLAIM 14

Independent claim 14 is directed to an apparatus embodiment of the present invention that is configured to retrieve, analyze, and display two subsets of data contained in larger sets of data. Claim 14 recites “retrieval means for retrieving a first set of data from a first predetermined data source and a second set of data from a second predetermined data source, said first set of data and said second set of data each being in any one of several possible formats.” *See Specification, paragraphs 21, 22, 30, 31, 40, 41, 42, 60, 78 and 81.* Claim 14 further recites “analyzing means for analyzing said first set of data to select a first subset of data

included in said first set of data based on a prior analysis of semantics, syntax, or position of said first subset of data included in a previous version of said first set of data, and for analyzing said second set of data to select a second subset of data included in said second set of data based on a prior analysis of semantics, syntax, or position of said second subset of data in a previous version of said second set of data.” *See Specification, paragraphs 44-73.* Finally, claim 14 recites “means for displaying said first subset of data and said second subset of data on a display device, said means for displaying including means for reformatting said first subset of data and said second subset of data if necessary for display on said display device.” *See Specification, paragraphs 30, 75, 76, 80-83, and 92.*

Claim 14 contains three limitations that are drafted under 35 U.S.C. § 112, sixth paragraph. Specifically, claim 14 recites “retrieval means for retrieving,” “analyzing means for analyzing,” and “means for displaying.” Each of these limitations is discussed in detail above with references to the portions of the specification in which the corresponding structure may be found.

C. DEPENDENT CLAIM 21

Claim 21, which depends on independent claim 14, is directed to an apparatus with the ability to reformat stored data if necessary. Claim 21 includes two means-plus-function limitations under 35 U.S.C. § 112, sixth paragraph. Specifically, claim 21 recites “storing means for storing” and “means for formatting.” Considering the former, claim 21 recites “storing means for storing said first subset of data and said second subset of data in a data store in a predefined storage format.” *See Specification, paragraphs 30 and 73-79.* Claim 21 also recites “means for formatting said first subset of data and said second subset of data in said storage format if the format of the first subset of data and said second subset of data is different from said storage format.” *See specification, paragraphs 30 and 73-79.*

D. DEPENDENT CLAIMS 11, 12, 13, AND 23

Claims 11, 12, 13 and 23 are essentially directed to using multiple techniques for identifying data for retrieval. Claim 13 depends from claim 12, which is dependent on claim 11. Claim 11, in particular, recites four means-plus-function limitations under 35 U.S.C. § 112, sixth paragraph: “first identifying means for identifying,” “second identifying means for identifying,” “third identifying means for identifying,” and “selecting means … for selecting.” The first, second, and third identifying means are specified as being “for identifying a first (respectively, second, third) candidate for selection as said second set of data using a first (respectively, second, third) method.” Thus, claim 11 essentially requires that three different techniques for identifying a subset of data within a greater set of data. Support for these limitations is found in the Specification, paragraphs 44-67; *see especially* paragraphs 60-67.

Similarly, claim 23 recites a “first strategy,” “second strategy,” and “third strategy” for selecting data to be retrieved. Claim 23 further recites using a “first weighting factor,” “second weighting factor,” and “third weighting factor” to select data. Support for these limitations is found in the Specification, paragraphs 44-67; *see especially* paragraphs 60-67.

Claim 12 recites that the selecting means includes a “first weighting,” “second weighting,” and “third weighting” to select data. Support for these limitations is found in the Specification, paragraphs 44-67; *see especially* paragraphs 60-67.

E. DEPENDENT CLAIMS 3-9, 21, 28 AND 29

Dependent claims 3-9, 21, 28 and 29 are essentially directed to storing retrieved data in a standard format and presenting the data to a user in a different format, such as its original format. Claims 4-9 are all either directly or indirectly dependent on claim 3. Claim 29 depends from claim 28. Claims 3 and 21 include means-plus-function limitations under 35 U.S.C. § 112, sixth paragraph. In particular, claim 3 recites “storing means for storing,” “means for formatting,” and

“means for recalling.” Similarly, claim 21 recites “storing means” and “means for formatting.” Support for these limitations of claims 3-9, 21, 28, and 29 is found in the Specification at, *e.g.*, paragraphs 30, 45 and 71-83.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- (1) Claims 1 and 14-21 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,727,159 to Kikinis (hereinafter, “Kikinis”).
- (2) Claims 1-14, 21-29 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Kikinis.
- (3) Claims 24, 25, 26, 28, and 29 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Kikinis in view of U.S. Patent No. 6,052,688 to Thorsen (hereinafter, “Thorsen”).

VII. ARGUMENTS

A. THE OFFICE ACTIONS IN GENERAL

Before turning to a detailed analysis of the Final Office Action’s deficiencies, a few words are in order regarding the Final Office Action in general. A first issue involves the clarity of the Final Office Action. Specifically, in many instances, it is not clear exactly which claims are being rejected. For example, although the Final Office Action purports that “Claims 14-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Dan Kikinis (U.S. 5,727,159),” the limitations of claims 1 and 21 are not addressed anywhere in that section. Such lack of clarity adversely prejudices Appellant because the Examiner’s grounds of rejection are frequently absent or opaque and therefore not amenable to rebuttal. To assist the Board in understanding the Final Office Action, to the extent possible, the following chart summarizes the alleged rejections. Note that in the present Appeal Brief, *Appellant considers each ground of rejection to be intended to encompass the claims that are purportedly rejected as well as those that are*

actually addressed.

	Claims Purportedly Rejected	Claims Actually Addressed	Claims Allegedly Rejected Yet Not Specifically Addressed
§ 102(b) over Kikinis	14-21	1, 14-20	21
§ 103(a) over Kikinis	1-13, 22-29	1-14, 21, 22, 23, 27	24, 25, 26, 28, 29
§ 103(a) over Kikinis in view of Thorsen	24-26	24, 25, 26, 28, 29	none

A second issue relates to the Examiner's grouping of claims for purposes of analysis. For example, the Examiner purports to reject claims 1, 14, 21, and 22 collectively. *See* Final Office Action, pages 2-3. However, in this group analysis, the Examiner considers only the limitations of claim 14 on the record. Although independent claims 1, 14, and 22 have some limitations in common, such are the minority. Moreover, claim 1 and claim 14 use the term "second set of data," for example, to refer to two different things. In claim 1, the "second set of data" should be interpreted as *being included in* a first set of data, while in claim 14, the "second set of data" should be interpreted as *including* a subset of data. Thus, the Examiner's collective analysis of claims 1, 14, 21, and 22 conflates the various limitation of these claims.

A third issue relates to the Examiner's consideration of Appellant's Amendments made prior to the Final Office Action. For example, despite amendments made to claims 1, 2, 14, 22, and 23 in the Response of June 24, 2004, *the Claim Rejection Sections of the Final Office Action are exactly identical to those of the prior Office Action.* The Examiner failed to consider the amended claims and instead merely asserted the identical rejections of the prior Office Action. As a particularly illustrative example, Appellant extensively amended claim 14 with the Response of June 24, 2004, yet the Examiner failed to address even one altered limitation of claim 14. Thus, the Final Office Action fails to adequately address each claim limitation as required by law and U.S. Patent Office policy.

B. THE REJECTION OF CLAIMS 1 AND 14-21 UNDER § 102(b) OVER KIKINIS IS UNSOUND AND MUST BE REVERSED

1. The Kikinis Reference

Kikinis discloses a system in which a proxy server is provided for an end-device to translate information received from the Internet into a simplified format readily useable by the end-device, which is presumed to have limited processing and display capabilities. *See* Kikinis, Abstract.

2. Regarding claim 1, Kikinis does not disclose “analyzing semantics, syntax, or position of said second set of data within said first set of data”

Independent claim 1 recites “analyzing semantics, syntax, or position of said second set of data within said first set of data.” The antecedent of “said second set of data” is “said first set of data including a second set of data.” Thus, this limitation requires analysis of the semantics, syntax, or position of a second set of data included in a first set of data. Kikinis completely lacks this limitation.

As best understood from the Final Office Action, the Examiner relies on Kikinis, column 10, lines 9-18, as allegedly meeting this limitation. The cited passage, however, merely recites downloading a home page that contains an image file:

At step 89 the Proxy-Server receives Home.HTML. Home pages typically contain at least one image file, which in many cases is a JPG file. Accordingly, at least two files must be downloaded to display a home page. At step 91 a request for a JPG image file is sent by the Proxy-Sever. The Proxy-Server receives this request at step 93 and send the image file to the Proxy-Server at step 95. The Proxy-Server receives the image file at step 97. There may be many more files than this, but a minimum representation has been made for simplicity in description.

Kikinis, column 10, lines 9-18.

Kikinis does not teach of analyzing the semantics, syntax, or position of such an image file. At most, Kikinis discloses conventionally downloading a home page that contains an image. Such standard downloading does not require an analysis of “semantics, syntax, or position” of a subset of data. Kikinis is typical of the prior art, in that it merely discloses conventionally downloading a standard web page (albeit via a proxy server). Conventional home page downloading merely blindly downloads each element on the page, without the need for any type of analysis whatsoever. There is absolutely no discussion, in the cited passage or elsewhere in Kikinis, of “analyzing semantics, syntax, or position of said second set of data within said first set of data.”

In the Final Office Action, the Examiner attempts to plug the hole in Kikinis regarding “analyzing semantics, syntax, or position of said second set of data within said first set of data” by citing an additional passage of Kikinis. In particular, the Examiner attempts to address the deficits of Kikinis regarding this limitation in the “Response To Arguments” section of the Final Office Action; *see* page 8. Referring to Kikinis, column 10, lines 52-56 and the previously-cited column 10, lines 9-18, the Examiner asserts that:

[T]he proxy server analyzes the home page format and retrieving [sic] the image file that included [sic] in the home page. Further, the format of the image file is recognized. In this case, it is a JPG format. Therefore, the proxy server must be able to analyzing [sic] the data format to retrieve further data as need [sic] for the request. In addition the system also analyzes the position of data on a page (see col. 10, lines 52-56). The claims languages [sic] are required [sic] a system that capable [sic] of analyzes [sic] semantics, syntax, or position of data.

Final Office Action, page 8.

Appellant respectfully disagrees. As discussed above, the first cited passage, column 10, lines 9-18, merely recites downloading a conventional home page that contains an image. Such a disclosure falls far short of anticipating the limitation at issue. The second, newly-cited passage similarly fails to meet this limitation. Although the Examiner appears to assert that Kikinis discloses analyzing both “format,” which the Examiner asserts is synonymous with “syntax” (*see* Final Office Action, page 7), and position, an inspection of the full Kikinis passage reveals that neither is the case:

In some cases, a display used by a field unit will be large enough to display an entire page from the WWW. In other cases, it will be preferable to present just a part of an entire page, because the display of the field unit may be too small to provide an entire page with adequate resolution. In these cases it will be necessary to zoom and pan to see an entire page. In one embodiment of the invention a field unit is provided with an auxiliary small display, to present information relative to the position on a page that may be presented on the main screen, as an aid in panning to other parts of the page.

Kikinis, column 10, lines 46-56. As can be seen from the full text, column 10, lines 46-56 has absolutely nothing to do with “analyzing semantics, syntax, or position of said second set of data within said first set of data.” Instead, the cited passage discloses using an auxiliary screen in a field unit to display position information regarding an image viewed on a main screen. There is no “first set of data within said second set of data.” At most, the cited passage discloses a first screen that displays a portion of an image and a second screen that displays information about what the first screen displays. There is no disclosure that the second screen displays a subset of data presented in the first screen. The screens discussed in column 10, lines 46-56 of Kikinis do not even display portions of the same data. In short, there is absolutely no teaching of

“analyzing semantics, syntax, or position of said second set of data within said first set of data” in the passages cited by the Examiner or anywhere else in Kikinis.

Accordingly, Appellants respectfully request reversal of the 35 U.S.C. § 102(b) rejection of claim 1 and all claims dependent therefrom.

3. Regarding claim 1, Kikinis does not disclose “building an agent, said agent comprising instructions based on said step of analyzing semantics, syntax, or position of said second set of data”

Independent claim 1 recites “building an agent, said agent comprising instructions based on said step of analyzing semantics, syntax, or position of said second set of data.” As discussed in detail herein, Kikinis completely fails to disclose this limitation.

Strikingly, the Examiner admits that Kikinis fails to disclose an agent as claimed. “Kikinis does not clearly disclose an agent comprising instructions based on said analysis of said data.” Final Office Action, page 5. Appellants agree; Kikinis does not disclose any agents whatsoever.

Nevertheless, the Examiner appears to contend that this limitation is inherent in Kikinis, although the Examiner places such argument in the § 103 rejection section. *See* Final Office Action, page 5 (“It is clear that the claimed provision is inherited [sic]”). Appellants strongly dispute such a characterization of Kikinis. The Examiner writes:

Kikinis discloses a program for processing commands from the user (Fig. 2, col. 6, lines 6-15). Clearly, the program must include instructions to execute user [sic] command. Therefore, this program corresponds to the “agent.”

Final Office Action, page 5. It would be difficult to overstate the leaps and flaws in the Examiner’s logic. The Examiner appears to contend that any program that processes and executes commands from a user meets the claim limitation. There are at least two problems with

that approach. First, the claim limitation at issue is not simply for “an agent.” Rather, the claim limitation calls for “an agent, said agent comprising instructions based on said step of analyzing semantics, syntax, or position of said second set of data.” The Examiner fails to even address the latter portion of this limitation. Undoubtedly, this is because it is absent from the Kikinis disclosure. Second, an agent is not, in general, any program that processes and executes user commands. Agents may be autonomous processes for identifying, retrieving, or formatting data. *See Specification, page 1, paragraph 3 and page 2, paragraph 6.* Thus, the Examiner’s assessment of whether Kikinis discloses “an agent, said agent comprising instructions based on said step of analyzing semantics, syntax, or position of said second set of data” fails to meet the requirements of § 102.

Accordingly, Appellants respectfully request reversal of the 35 U.S.C. § 102(b) rejection of claim 1 and all claims dependent therefrom.

4. Regarding claim 1, Kikinis does not disclose that “said instructions are to be used to subsequently retrieve a third set of data from said first predetermined data source and select a fourth set of data included in said third set of data”

Independent claim 1 recites that certain “instructions are to be used to subsequently retrieve a third set of data from said first predetermined data source and select a fourth set of data included in said third set of data.” Kikinis simply fails to disclose this limitation.

The Examiner does not address this limitation anywhere in the Final Office Action. Moreover, Kikinis fails to disclose anything remotely like the limitation at issue here. Kikinis’ disclosure cannot address this limitation because it is directed to an entirely different technology. Kikinis is not concerned with intelligently learning where certain data subsets are positioned within a set of data so as to allow for subsequent retrieval of certain data. Instead, Kikinis is

directed to using a proxy server to assist low-computing power devices in browsing the internet. Therefore, Kikinis has no need for this limitation. The limitation of “instructions are to be used to subsequently retrieve a third set of data from said first predetermined data source and select a fourth set of data included in said third set of data” is entirely absent for the Kikinis disclosure.

Accordingly, Appellants respectfully request reversal of the 35 U.S.C. § 102(b) rejection of claim 1 and all claims dependent therefrom.

5. Regarding claims 14-21, Kikinis does not disclose “retrieving a first set of data from a first predetermined data source and a second set of data from a second predetermined data source, said first set of data and said second set of data each being in any one of several possible formats”

Independent claim 14 recites “retrieving a first set of data from a first predetermined data source and a second set of data from a second predetermined data source, said first set of data and said second set of data each being in any one of several possible formats.” Kikinis fails to disclose this limitation.

The Examiner stakes out a position that the “first set of data” corresponds to a home page and the “second set of data” corresponds to some elusive data that “can be cached from other Internet servers.” Final Office Action, page 2. Specifically, with respect to the “second set of data,” the Examiner refers to Kikinis, column 12, lines 11-30 and writes:

Data can be cached from other Internet servers. Therefore, this data is corresponding [sic] to the second set of data.

Although the Examiner’s reasoning here is far from clear, the cited portion of Kikinis utterly fails to reveal any “second set of data” as claimed.

Surely the Examiner is not referring to the portion of column 12, lines 11-30 that states that “[t]here may be many more files than this, but a minimum representation has been made for

simplicity in description.” That line refers to additional files *within the home page* under discussion. Because the Examiner maintains that such a home page corresponds to the “first set of data,” it would be improper for the Examiner to argue that these “many more files,” which lie within the home page, correspond to the “second set of data.” If this is indeed the Examiner’s approach, then the limitation discussed immediately below (“analyzing said first set of data … analyzing the second set of data”) cannot be met. Specifically, if the “second set of data” corresponds to a file within the home page, as the Examiner possibly contends, then there can be no “analyzing said second set of data to select a second subset of data included in said second set of data based on a prior analysis of semantics, syntax, or position of said second subset of data in a previous version of said second set of data.” This is because, if Appellant understands the Examiner’s argument, the “second set of data” is already a subset of a home page, and Kikinis utterly fails to discuss any “second subset of data included in said second set of data,” let alone an analysis of a “second set of data to select a second subset of data … based on a prior analysis of semantics, syntax, or position.”

It is also possible, although far from clear, that the Examiner is asserting some type of inherency argument with the statement, “[d]ata can be cached from other Internet servers.” Final Office Action, page 2 (emphasis added). Of course, a rejection under § 102 cannot be maintained by altering or reading additional features into the cited prior art. It is not inherent that there is some “other Internet server,” as the Examiner contends, because there are ways to practice Kikinis’ invention using a single Internet server. *See* Final Office Action, page 2. Indeed, despite the Examiner’s application of quotation marks, the cited portion of Kikinis does not refer to any “other Internet server” that provides anything corresponding to a second set of data as claimed. Thus, an inherency argument fails to remove the deficiencies of Kikinis.

Accordingly, Appellants respectfully request reversal of the 35 U.S.C. § 102(b) rejection

of claims 14-21 and all claims dependent therefrom.

6. Regarding claims 14-21, Kikinis does not disclose "analyzing said first set of data to select a first subset of data included in said first set of data based on a prior analysis of semantics, syntax, or position of said first subset of data included in a previous version of said first set of data, and for analyzing said second set of data to select a second subset of data included in said second set of data based on a prior analysis of semantics, syntax, or position of said second subset of data in a previous version of said second set of data"

Independent claim 14 recites "analyzing said first set of data to select a first subset of data included in said first set of data based on a prior analysis of semantics, syntax, or position of said first subset of data included in a previous version of said first set of data, and for analyzing said second set of data to select a second subset of data included in said second set of data based on a prior analysis of semantics, syntax, or position of said second subset of data in a previous version of said second set of data." Kikinis fails to disclose this limitation.

As discussed immediately above, it is not clear how the Examiner interprets the "second set of data." The Examiner's own words regarding this claim limitation are not helpful:

As noted above, the data can be obtained from different providers, therefore, the proxy server must be able to analyzing [sic] the data to retrieve further data as need [sic] for the request.

Final Office Action, page 3. Although far from clear, this assertion appears to be loosely consistent with the Examiner's prior interpretation of "second set of data." Specifically, elsewhere in the Final Office Action, the Examiner appears to contend that the "second set of data" corresponds to either (1) some additional file within the home page or (2) to some data

“cached from other Internet servers.” Neither interpretation of “second set of data” supports the Examiner’s analysis of the present claim limitation.

If the Examiner contends that the “second set of data” corresponds to (1) some additional file in the home page, then Kikinis absolutely fails to “select a second subset of data included in said second set of data” as required by the remainder of the claim limitation at issue. Specifically, Kikinis utterly fails to discuss subsets of any additional file within the home page. Kikinis utterly fails to discuss any type of analysis “based on a prior analysis of semantics, syntax, or position of said second subset of data.” Kikinis utterly fails to disclose any analysis based on “previous version of said second set of data.” In short, Kikinis cannot support a rejection that interprets the “second set of data” as some additional file in the home page.

Nor can Kikinis support a rejection that interprets the “second set of data” as (2) data “cached from other Internet servers.” *See* Final Office Action, page 3. As discussed immediately above, the Examiner appears to assert that such data are inherent in Kikinis’ disclosure. Appellants respectfully disagree. Moreover, even if such a teaching were present in Kikinis (and Appellants do not so concede), it would yet fall short of meeting the full claim limitation. Specifically, there is no teaching in Kikinis of any subsets of these data allegedly “cached from other Internet servers.” There is no teaching in Kikinis of any analysis of these data, let alone an analysis based on a “prior analysis of semantics, syntax, or position.” And there is no teaching in Kikinis of using a “previous version of said second set of data” under this interpretation. In sum, Kikinis cannot support a rejection that interprets the “second set of data” as data “cached from other Internet servers.”

Moreover, the Examiner completely fails to consider the limitation of analysis “based on a prior analysis.” The Final Office Action is absolutely silent with respect to this limitation. Kikinis does not, and cannot, support this limitation. With no discussion in the Final Office

Action and no disclosure of this limitation by Kikinis, the rejection must be reversed.

Accordingly, Appellants respectfully request reversal of the 35 U.S.C. § 102(b) rejection of claims 14-21 and all claims dependent therefrom.

7. Regarding claim 21, Kikinis does not disclose formatting stored data if its presentation format differs from its storage format

Although the Examiner purports to reject claim 21 under 35 U.S.C. § 102(b) over Kikinis, the Final Office Action does not address any of its limitations. That is, no analysis of claim 21 appears in the Final Office Action. Nevertheless, Appellant proceeds to discuss why claim 21 is patentable over Kikinis.

Claim 21 recites “formatting said first subset of data and said second subset of data in said storage format if the format of the first subset of data and said second subset of data is different from said storage format.” Kikinis fails to disclose this limitation. In particular, Kikinis lacks any teaching whatsoever of formatting data contingent on a determination of whether its presentation format differs from its storage format. Instead, Kikinis is directed to a single presentation format, which depends on the capabilities of a “hand-held unit” rather than any comparison of stored data format with a presentation format. *See* Kikinis, column 7, lines 13-25. Kikinis has no need to compare presentation formats to storage formats because Kikinis teaches of choosing a format based on an entirely different criteria: the display capabilities of a “hand-held unit.” *See Id.* Thus, Kikinis neither teaches nor suggests formatting stored data if its presentation format differs from its storage format.

Accordingly, Appellants respectfully request reversal of the 35 U.S.C. § 102(b) rejection of claim 21 and all claims dependent therefrom.

C. THE REJECTION OF CLAIMS 1-14 and 21-29 UNDER § 103(a) OVER KIKINIS IS UNSOUND AND MUST BE REVERSED

1. Regarding claims 1-13, Kikinis does not disclose "analyzing semantics, syntax, or position of said second set of data within said first set of data"

A discussion of this limitation is found above in Section VII(B)(2), which is incorporated by reference herein in its entirety. In addition to the arguments presented above in relation to the § 102(b) rejection, the following arguments also apply to the rejection of claims 1-13 under § 103.

Kikinis neither teaches nor suggests "analyzing semantics, syntax, or position of said second set of data within said first set of data." Indeed, Kikinis has no need for this limitation. Kikinis is directed to using a proxy server to download home pages for a relatively low-end computer that is ordinarily incapable of internet browsing functions. *See* Kikinis, Abstract. Kikinis has no need to analyze "semantics, syntax, or position" of any data set because Kikinis merely downloads a home page in a standard manner (albeit through a proxy server). Thus, Kikinis entirely fails to suggest the limitation of "analyzing semantics, syntax, or position of said second set of data within said first set of data," and cannot support a rejection under §103.

Accordingly, Appellants respectfully request reversal of the 35 U.S.C. § 103(a) rejection of claims 1-13 and all claims dependent therefrom.

2. Regarding claims 1-13, Kikinis does not disclose "building an agent, said agent comprising instructions based on said step of analyzing semantics, syntax, or position of said second set of data"

In Section VII(B)(3) above, which is incorporated herein by reference in its entirety, Appellant discusses how Kikinis fails to meet this limitation. As discussed above, the Examiner goes so far as to admit that this limitation is absent from Kikinis. Moreover, Kikinis fails to suggest this limitation. Specifically, Kikinis is directed to downloading home pages to a

relatively low-end computer through a proxy server. Kikinis has no need to analyze “semantics, syntax, or position” of any data, let alone a need to build an agent for that purpose. Instead, Kikinis relies on conventional home page downloading techniques. There is absolutely no teaching anywhere in Kikinis of “building an agent, said agent comprising instructions based on said step of analyzing semantics, syntax, or position of said second set of data.”

Accordingly, Appellants respectfully request reversal of the 35 U.S.C. § 103(a) rejection of claims 1-13 and all claims dependent therefrom.

3. Regarding claims 1-13, Kikinis does not disclose that “instructions are to be used to subsequently retrieve a third set of data from said first predetermined data source and select a fourth set of data included in said third set of data”

This limitation is addressed in Section VII(B)(4) above, which argument is incorporated by reference herein in its entirety. As discussed above, the Examiner fails to discuss this limitation anywhere in the Final Office Action.

Kikinis fails to disclose or suggest this limitation. Moreover, Kikinis has no need for this limitation, at least because the Kikinis invention is directed to an entirely different technology. Kikinis is not concerned with intelligently learning where certain data subsets are positioned within a set of data so as to allow for subsequent retrieval of certain data. Instead, Kikinis is directed to using a proxy server to assist low-computing power devices in browsing the internet. Therefore, Kikinis has no need for this limitation. The limitation of “instructions are to be used to subsequently retrieve a third set of data from said first predetermined data source and select a fourth set of data included in said third set of data” is entirely absent for the Kikinis disclosure.

Accordingly, Appellants respectfully request reversal of the 35 U.S.C. § 103(a) rejection of claims 1-13 and all claims dependent therefrom.

4. Regarding claims 14, 21, and 25, Kikinis does not disclose "retrieving a first set of data from a first predetermined data source and a second set of data from a second predetermined data source, said first set of data and said second set of data each being in any one of several possible formats"

As discussed above in Section VII(B)(5), Kikinis fails to meet this limitation. These arguments are incorporated by reference herein in their entireties.

Kikinis neither teaches nor suggests "retrieving a first set of data from a first predetermined data source and a second set of data from a second predetermined data source, said first set of data and said second set of data each being in any one of several possible formats." Indeed, Kikinis has no need for this limitation, because Kikinis is directed to downloading only a single home page. Kikinis does not suggest this limitation and has no need to suggest this limitation because Kikinis fails to contemplate multiple data sources; all of Kikinis' data flows through a proxy server.

Accordingly, Appellants respectfully request reversal of the 35 U.S.C. § 103(a) rejection of claims 14, 21 and 25 and all claims dependent therefrom.

5. Regarding claims 14, 21, and 25, Kikinis does not disclose "analyzing said first set of data to select a first subset of data included in said first set of data based on a prior analysis of semantics, syntax, or position of said first subset of data included in a previous version of said first set of data, and for analyzing said second set of data to select a second subset of data included in said second set of data based on a prior analysis of semantics, syntax, or position of said second subset of data in a previous version of said second set of data"

Appellant addresses this limitation in Section VII(B)(6) above, which arguments are

incorporated by reference herein in their entireties. The following observations also apply.

Kikinis fails to teach or suggest “analyzing said first set of data to select a first subset of data included in said first set of data based on a prior analysis of semantics, syntax, or position of said first subset of data included in a previous version of said first set of data, and for analyzing said second set of data to select a second subset of data included in said second set of data based on a prior analysis of semantics, syntax, or position of said second subset of data in a previous version of said second set of data.” Moreover, Kikinis has no need for this limitation. Kikinis is concerned with downloading a home page to a low-end computer by way of a proxy server. Kikinis therefore has no need to analyze any set of data to select a subset of data based on a prior analysis of semantics, syntax, or position. Kikinis has no need for a single prior analysis, let alone two such analyses: one for a first set of data and one for a second set of data. In short, Kikinis neither teaches nor suggests the limitation at issue.

Accordingly, Appellants respectfully request reversal of the 35 U.S.C. § 103(a) rejection of claims 14, 21 and 25 and all claims dependent therefrom.

6. Regarding claim 21, Kikinis does not disclose formatting stored data if its presentation format differs from its storage format

As discussed above in Section VII(B)(7), Kikinis fails to disclose “formatting stored data if its presentation format differs from its storage format.” The arguments from that section are hereby incorporated by reference in their entireties. In addition, the following remarks apply.

Kikinis has no need to format stored data if its presentation format differs from its storage format because Kikinis’ choice of format depends only on “information about the hand-held unit, such as CPU type and power, screen size, type and resolution, presence of a pointer device, and sound capability.” *See* Kikinis, column 7, lines 13-25. Thus, Kikinis neither teaches nor suggests “formatting stored data if its presentation format differs from its storage format.”

Accordingly, Appellants respectfully request reversal of the 35 U.S.C. § 103(a) rejection of claim 21.

7. Regarding claims 11, 12, 13, and 23, Kikinis fails to disclose multiple strategies for selecting or retrieving a subset of data

In Section V(D) above, Appellant discusses the above features of claims 11, 12, 13 and 23. In particular, each of these claims is essentially directed to using multiple, different strategies to select a subset of data. Claim 11 recites “first identifying means for identifying,” “second identifying means for identifying,” and “third identifying means for identifying” a subset of data. Claim 13 depends from claim 12, which depends from claim 11. Claim 23 recites a “first strategy,” “second strategy,” and “third strategy” for retrieving data. Kikinis utterly fails to disclose using multiple strategies to select or retrieve a subset of data.

Indeed, Kikinis is directed to conventionally downloading data through a proxy server. Kikinis discloses exactly one technique for downloading data, that of conventional downloading by a proxy server and transfer to a hand-held unit. *See* Kikinis, Abstract. Moreover, Kikinis has absolutely no disclosure of selecting a subset of data using multiple techniques. Kikinis has no need to use multiple techniques to select or retrieve data, because Kikinis teaches that all data is retrieved using a single proxy server in a conventional manner. Accordingly, Kikinis neither teaches nor suggests using multiple techniques to retrieve or select a subset of data.

Accordingly, Appellants respectfully request reversal of the 35 U.S.C. § 103(a) rejection of claims 11, 12, 13 and 23.

8. Regarding claims 12, 13, and 23, Kikinis fails to disclose the use of multiple weighting factors to select a subset of data

Claims 12, 13 and 23 recite using a first , second, and third “weighting” or “weighting factor” to select data. Kikinis has absolutely no teaching or suggestion of such limitations.

Furthermore, Kikinis has no need to use multiple weighting or weighting factors, as Kikinis never needs to choose data to download. Instead, the downloaded data of Kikinis is entirely chosen by the user. *See* Kikinis, column 6, lines 6-27. Thus, Kikinis neither teaches nor suggests the use of multiple weighting factors to select a subset of data.

Accordingly, Appellants respectfully request reversal of the 35 U.S.C. § 103(a) rejection of claims 12, 13 and 23.

9. Regarding claims 3-9, 21, 28, and 29, Kikinis fails to disclose formatting stored data if its presentation format differs from its storage format

As discussed above in Section VII(B)(7), Kikinis fails to disclose formatting stored data if its presentation format differs from its storage format. The arguments from that section are hereby incorporated by reference in their entireties. In addition, the following remarks apply.

Each of claims 3-9, 21, 28 and 29 recite some form of formatting stored data if its presentation format differs from its storage format. Claim 3 recites “formatting said fourth set of data for display on a display device in a presentation format if said presentation format is different from said storage format.” Claim 21 recites “formatting said first subset of data and said second subset of data in said storage format if the format of the first subset of data and said second subset of data is different from said storage format.” Claim 28 recites “formatting said fourth set of data for display on a display device in a presentation format if said presentation format is different from said storage format.” The remaining dependent claims include such limitations by virtue of their dependency.

Kikinis not only fails to disclose the above-referenced limitations, but also fails to suggest the same. Indeed, Kikinis discloses a single presentation format, which depends on the capabilities of a “hand-held unit” rather than any comparison of stored data format with a presentation format. *See* Kikinis, column 7, lines 13-25. Kikinis has no need to compare

presentation formats to storage formats because Kikinis teaches of choosing a format based on an entirely different criteria: the display capabilities of a “hand-held unit.” *See* Kikinis, column 7, lines 13-25. Thus, Kikinis neither teaches nor suggests formatting stored data if its presentation format differs from its storage format.

Accordingly, Appellants respectfully request reversal of the 35 U.S.C. § 103(a) rejection of claims 3-9, 21, 28, and 29.

**D. THE REJECTION OF CLAIMS 24, 25, 26, 28, AND 29 UNDER § 103(a)
OVER KIKINIS IN VIEW OF THORSEN IS UNSOUND AND MUST BE
REVERSED**

The Examiner’s attempt to combine Kikinis with Thorsen are improper under 35 U.S.C. § 103(a) and associated case law. Specifically, the Examine has not provided proper motivation to combine these references. The Examiner states:

The teaching of Thorsen also is in the same field with Kikinis (access data and retrieving data). It would be obvious to one with ordinary skill in the art at the time the invention was made to apply the teaching of Thorsen about specifying time interval [sic] for the data to be retrieved, into the system of Kikinis, because the combination would provided [sic] more controlling [sic] in the files to be accessed. Specified user can only access data files in a limited of time [sic]. A certain data can only be retrieved at a certain time.

Final Office Action, page 7. As best understood by Appellant, the Examiner appears to argue that (1) Kikinis and Thorsen are in the same inventive field, and (2) it would be obvious to add the access restrictions of Thorsen to the disclosure of Kikinis. As per (1), Appellant disputes that Kikinis are in the same inventive field. Indeed, the patents to Kikinis and Thorsen are classified in entirely different U.S. classes. There is absolutely no overlap in U.S. classification between the two applications. Moreover, Kikinis is directed to facilitating data transfer to users, while

Thorsen is directed to restricting data transfer to users according to information in “access nodes.” *See, e.g.*, Thorsen, Abstract. That is, the disclosures of Kikinis and Thorsen are fundamentally at odds with each-other, and may not be properly combined.

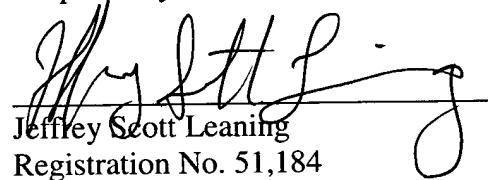
As per (2), Appellant respectfully disagrees with the Examiner’s alleged motivation to combine. Specifically, the Examiner appears to assert that motivation to add access restrictions as taught by Thorsen to the disclosure of Kikinis lies in allowing greater user control. In fact, precisely the opposite is the case: adding the access restrictions of Thorsen to the disclosure of Kikinis would serve only to further restrict user control of information. There is no motivation to add such restrictions to the disclosure of Kikinis. Indeed, such a combination runs contrary to the very heart of Kikinis’ disclosure, which is entirely directed to allowing users greater access to publicly available web information.

Accordingly, Appellants respectfully request reversal of the 35 U.S.C. § 103(a) rejection of claims 24, 25, 26, 28, and 29.

VIII. CONCLUSION

In view of the foregoing, Appellant respectfully requests that the Board reverse the prior art rejections set forth in the Final Office Action, and allow all of the pending claims.

Respectfully submitted,



Jeffrey Scott Leaning
Registration No. 51,184

Date: June 29, 2005

Hunton & Williams LLP
1900 K. St., NW, Suite 1200
Washington, D.C. 20006-1109
Tel: (202) 955-1500
Fax: (202) 778-2201



APPENDIX - Pending Claims

What is claimed is:

1. Apparatus comprising:

retrieval means for retrieving a first set of data from a first predetermined data source,
said first set of data including a second set of data;

analyzing means for analyzing semantics, syntax, or position of said second set of data
within said first set of data; and

means for building an agent, said agent comprising instructions based on said analysis of
said semantics, syntax, or position of said second set of data, wherein said instructions are to be
used by said agent to subsequently retrieve a third set of data from said first predetermined data
source and select a fourth set of data included in said third set of data.

**2. Apparatus as claimed in claim 1 wherein said retrieval means, said analyzing means, and
said means for building an agent all reside and execute on a single local computer device.**

3. Apparatus as claimed in claim 1 further comprising:

storing means for storing said fourth set of data in a data store in a predetermined storage
format, said storing means including means for formatting said fourth set of data in said storage
format if the format of the third data set is different from said storage format, and

means for recalling said fourth set of data from said data store and for formatting said
fourth set of data for display on a display device in a presentation format if said presentation
format is different from said storage format.

**4. Apparatus as claimed in claim 3 wherein said display device is a television monitor and
said means for recalling is incorporated into a cable set-top box, said retrieval means, said
analyzing means and said storing means all reside and execute on a central computer which
exchanges data with said set-top box via a cable connection.**

**5. Apparatus as claimed in claim 3 wherein said first set of data includes data about a device
state from a home gateway system.**

6. Apparatus as claimed in claim 5 wherein said retrieval means, said analyzing means, and said storing means all reside and execute on a computer which communicates with said home gateway system over the Internet.

7. Apparatus as claimed in claim 3 wherein said display device is a screen on a web-enabled telephone and wherein said means for recalling is incorporated into said web-enabled telephone.

8. Apparatus as claimed in claim 7 wherein said retrieval means, said analyzing means, and said storing means all reside and execute on a central computer which exchanges data with said web-enabled telephone via a cellular telephone network.

9. Apparatus as claimed in claim 3 wherein said display device is a screen on a PDA.

10. Apparatus as claimed in claim 1 wherein said first predetermined data source includes status information for an external device, and wherein said first set of data includes said status information.

11. Apparatus as claimed in claim 1 wherein said analyzing means comprises:
first identifying means for identifying a first candidate for selection as said second set of data using a first method;
second identifying means for identifying a second candidate for selection as said second set of data using a second method different from said first method;
third identifying means for identifying a third candidate for selection as said second set of data using a third method different from said second method and said first method; and
selecting means, responsive to said first, second, and third identifying means, for selecting one of said first, second, and third candidates as said second set of data.

12. Apparatus as claimed in claim 11 wherein said selecting means selects one of said first, second, and third candidates as said second set of data based on a first weighting assigned to said first identifying means, a second weighting assigned to said second identifying means, and a

third weighting assigned to said third identifying means.

13. Apparatus as claimed in claim 12 further comprising means, responsive to said selecting means, for altering said first weighting based on a degree of correspondence between said second set of data selected by said selecting means and said first candidate, for altering said second weighting based on a degree of correspondence between said second set of data selected by said selecting means and said second candidate, and for altering said third weighting based on a degree of correspondence between said second set of data selected by said selecting means and said third candidate.

14. Apparatus comprising:

retrieval means for retrieving a first set of data from a first predetermined data source and a second set of data from a second predetermined data source, said first set of data and said second set of data each being in any one of several possible formats;

analyzing means for analyzing said first set of data to select a first subset of data included in said first set of data based on a prior analysis of semantics, syntax, or position of said first subset of data included in a previous version of said first set of data, and for analyzing said second set of data to select a second subset of data included in said second set of data based on a prior analysis of semantics, syntax, or position of said second subset of data in a previous version of said second set of data; and

means for displaying said first subset of data and said second subset of data on a display device, said means for displaying including means for reformatting said first subset of data and said second subset of data if necessary for display on said display device.

15. Apparatus as claimed in claim 14, wherein said first predetermined data source is an internet resource.

16. Apparatus as claimed in claim 14 wherein said second predetermined data source is an enterprise intranet resource.

17. Apparatus as claimed in claim 14 wherein said display device is a computer monitor.

18. Apparatus as claimed in claim 14 wherein said display device is a television monitor and wherein said means for displaying is incorporated into a cable set-top box.

19. Apparatus as claimed in claim 14 wherein said display device is a screen on a web-enabled telephone.

20. Apparatus as claimed in claim 14 wherein said display device is a screen on a PDA.

21. Apparatus as claimed in claim 14 further comprising storing means for storing said first subset of data and said second subset of data in a data store in a predefined storage format, said storing means including means for formatting said first subset of data and said second subset of data in said storage format if the format of the first subset of data and said second subset of data is different from said storage format.

22. A method comprising the steps of:

retrieving a first set of data from a predetermined data source, said first set of data including a second set of data;
analyzing semantics, syntax, or position of said second set of data within said first set of data; and

building an agent, said agent comprising instructions based on said step of analyzing semantics, syntax, or position of said second set of data, wherein said instructions are to be used to subsequently retrieve a third set of data from said first predetermined data source and select a fourth set of data included in said third set of data.

23. The method of claim 22, further comprising the steps of:

assigning a first weighting factor to a first strategy for retrieving said third set of data;
assigning a second weighting factor to a second strategy for retrieving said third set of data;

assigning a third weighting factor to a third strategy for retrieving said third set of data;
determining a first candidate for said third set of data using said first strategy, a second

candidate using said second strategy, and a third candidate for said third set of data using said third strategy;

selecting one of said first, second, and third candidates as a result third set of data based on said first, second, and third weighting factors;

adjusting said first weighting factor based on whether said first candidate matches said result third set of data, said second weighting factor based on whether said second candidate matches said result third set of data, and said third weighting factor based on whether said third candidate matches said result third set of data.

24. Apparatus as claimed in claim 1 wherein said first predetermined data source is a web page.

25. Apparatus as claimed in claim 14 further comprising a scheduling application for activating said retrieval means at scheduled time intervals.

26. The method as claimed in claim 22 further comprising the step of executing said agent to subsequently retrieve said third set of data from said first predetermined data source and select said fourth set of data included in said third set of data.

27. The apparatus of claim 1 wherein said second set of data is similar to said fourth set of data.

28. The method of claim 26 further comprising the steps of:

storing said fourth set of data in a data store in a predetermined storage format,

formatting said fourth set of data in said storage format if the format of the third data set is different from said storage format, and

recalling said fourth set of data from said data store and formatting said fourth set of data for display on a display device in a presentation format if said presentation format is different from said storage format.

29. The method of claim 28 wherein said step of executing said agent is repeated at

scheduled time intervals.